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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/769,793	02/03/2004	Masahiro Inoue	Q79163	9251

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EXAMINER
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PHU, SANH D

ART UNIT	PAPER NUMBER
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2618

MAIL DATE	DELIVERY MODE
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05/21/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/769,793	<b>Applicant(s)</b> INOUE, MASAHIRO	
	<b>Examiner</b> Sanh D. Phu	<b>Art Unit</b> 2618	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 02 April 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 9-17 is/are rejected.
- 7) ☒ Claim(s) 2-8 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

1. This Office Action is responsive to the Amendment filed on 4/2/07.

Accordingly, claims 1-17 are currently pending.

### *Claim Objections*

2. Claim 11 is objected to because of the following informalities:

Claim 11, line 2 recites the limitation "said electrically conductive members". The limitation is lack of antecedent basis. The limitation is suggested to be changed to --said electrically conductive member--.

Claim 11, lines 2-3, recites the limitation "said inner peripheral surfaces". The limitation is lack of antecedent basis. The limitation is suggested to be changed to -- said inner peripheral surfaces--.

Claim 11, line 4, recites the limitation "said substrate". The limitation is lack of antecedent basis.

Appropriate correction is required.

*Claim Rejections – 35 USC § 102*

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this

Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1, 9, 11 and 17 are rejected under 35 U.S.C. 102(b) as being anticipated by Chaum et al (5,485,520), newly-cited.

–Regarding to claim 1, Chaum et al discloses a dedicated short-range communication on-vehicle apparatus (34) (see figure 1) mounted on a motor vehicle in a dedicated short-range communication system for an intelligent traffic system, comprising:

an antenna (300) (see figure 3) being a fixed microstrip antenna array having, therefore, a fixed directivity in a predetermined direction for supporting a communication link (22) (see figure 1) (see col. 7, lines 1–7, col. 12, lines 8–20) ;

a radio module (302) (see figure 3) for performing transmission/reception of radio wave with road-side radio equipment (20b) (see figure 1) by way of said antenna (see col. 12, lines 8-57);

a data processing unit (comprising (312, 310, 308)) for processing transmission/reception data transmitted/received by said radio module (see col. 12, lines 8-57); and

a box-like housing (see figure 3A) for housing therein said antenna, said radio module and said data processing unit in a unitary structure (see col. 12, lines 58-59),

wherein said box-like housing is adapted to be fixedly attached onto a windshield of the motor vehicle with a mounting plate (inherently included, as a surface of said housing fixedly attached onto the windshield) being disposed on the radiation side of said antenna by means of an adhesive member (see figure 1, col. 12, lines 8-24), and

wherein at least a radio wave aperture portion of said mounting plate is inherently made of a radio wave transmissible material so that radio signals can

be transmitted/received from/to the antenna through the surface to/from the road-side radio equipment (see figure 1).

-Regarding to claim 9, Chaum et al discloses that the circuitry (shown in figure 3) being an electrically conductive member of the apparatus comprises a display (318) and keypad (316) (see figure 3A, col. 12, lines 58-62) appeared on an outer side of a peripheral surface of said box-like housing (see figure 3A), the display and keypad inherently having an electrically conductive portion is disposed on an inner side of said peripheral surface of said box-like housing, and the electrically conductive member inherently has a region for the antenna (300) (see figures 3 and 3A) corresponding to orientation of directivity of said antenna disposed internally of said box-like housing.

-Regarding to claim 11, as applied to claim 9, Chaum et al teaches that said electrically conductive member has the display and keypad comprising a region disposed on said inner peripheral surfaces of said box-like housing at a side of the housing located oppositely to an outer peripheral portions of a surface disposed internally of said box-like housing at an opposite side of the housing.

–Regarding to claim 17, as applied to claim 9, Chaum et al teaches that said electrically conductive has the display and the keypad comprising the electrically conductive portion disposed on a surface side of the inner of said peripheral surface of said box-like housing.

*Claim Rejections – 35 USC § 103*

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 10 and 12–16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chaum et al.

–Regarding to claim 10, Chaum et al does not teach said electrically conductive member has the display and keypad is disposed on an inner peripheral surface located oppositely to the orientation directivity of said antenna disposed internally of said box-like housing.

However, Chaum et al teaches that said antenna is disposed internally of said box-like housing (see figure 3A); and Chaum et al further teaches that the directivity of the antenna can be designed in a certain direction (see col. 12, lines 14–16).

It would have been obvious for a person skilled in the art to implement the antenna to have the directivity toward the road side radio equipment for optimally supporting the communication link (22) (see figure 1).

With such the implementation, Chaum et al teaches said electrically conductive member has the display and keypad is disposed on an inner peripheral surface located oppositely to the orientation directivity of said antenna disposed internally of said box-like housing.

–Regarding to claim 12, Chaum et al does not teach a label carrying predetermined information and designed to be stuck on said mounting plate; and a seal stuck on said mounting plate so as to cover said label.

However, Chaum et al teaches the apparatus has label(s) (AMTECH, DYNICASH) carrying predetermined information appears at locations on a surface opposite to said mounting plate (see figure 3A).

Sticking a label on a surface of plate and using a seal to cover said label is well-known and within skills of one skilled in the art at the time the invention was made, and the examiner takes Official Notice.

Since these labels obviously does not affect the operation of the circuitry (shown in figure 3) of the apparatus, it would have been obvious for one skilled in the art to alternatively implement Chaum et al in such a way that the label(s) would designed to be stuck on said mounting plate at a surface contacting the windshield; and a seal would be stuck on said mounting plate so as to cover said label so that the label(s) could be easily seen from outside the vehicle.

–Regarding to claim 13, Chaum et al does not teach that said seal is a semitransparent seal.

Using a semitransparent seal for sealing is well-known in the art.

It would have been obvious for one skilled in the art to implement Chaum et al in such a way that said seal is a semitransparent seal, so that the label(s) so that the seal could cover the label(s) as required.

–Regarding to claim 14, Chaum et al does not teach that said seal is capable of being peeled off.

Using a seal of material easily of the seal to be peeled off to be used again is well-known in the art.

It would have been obvious for one skilled in the art to implement Chaum et al in such a way that said seal would be made of material capable of being peeled off to be used again, as long as the seal could cover the label(s) as required.

–Regarding to claim 15, Chaum et al does not teach that said adhesive member is constituted by a double-side adhesive tape shaped in a predetermined character pattern.

However, Chaum et al teaches that said adhesive member can be any type as long as the housing can be fixedly attached onto the windshield so as to provide unimpeded microwave communication with the road side radio equipment (see col. 12, lines 20–24).

Using double-side adhesive tape shaped in a predetermined character pattern for attaching an article to a surface is well-known and within skills of a person skilled in the art, and the examiner takes Official Notice.

It would have been obvious for one skilled in the art to implement Chaum et al in such a way that said adhesive member would be constituted by a double-side adhesive tape shaped in a predetermined character pattern for attaching the housing fixedly attached onto the windshield so that the housing would be mounted on the windshield as required.

-Regarding to claim 16, as applied to claim 15, in Chaum et al, the double-side adhesive tape, as a physical substance, inherently has a certain color.

*Allowable Subject Matter*

7. Claims 2-8 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

*Response to Arguments*

8. Applicant's arguments, filed 4/2/07, have been fully considered. The previous rejections have been withdrawn.

As results, claims 2-8 are indicated allowable as set forth above.

However, claims 1 and 9–17 are deemed not patentable over Chaum et al because of reasons set forth in this Office Action.

*Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sanh D. Phu whose telephone number is (571)272–7857. The examiner can normally be reached on M–Th from 7:00–17:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Matthew D. Anderson can be reached on (571) 272–4177. The fax phone number for the organization where this application or proceeding is assigned is 571–273–8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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SP

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PATENT EXAMINER

5/09/07

*Sanh D. Phu*